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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/769,970	02/02/2004	Thomas J. Prorock	RPS920030156US1	9128

47052 7590 09/26/2008

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EXAMINER	
BROWN, ALVIN L	

ART UNIT	PAPER NUMBER
3622	

NOTIFICATION DATE	DELIVERY MODE
09/26/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@sawyerlawgroup.com

Office Action Summary	Application No.	Applicant(s)	
	10/769,970	PROROCK ET AL.	
	Examiner	Art Unit	
	ALVIN L. BROWN	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 July 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 22, 2008 has been entered. Claims 1 and 8 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The word unvalidated is unclear since the word does not appear in a dictionary. Examiner interprets "unvalidated" as invalidated.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al (6,837,428) in view of Trika et al. (2005/0131761) further in view of Rando et al., (5,128,520).

As per claim 1 Lee discloses a method for processing coupons by a self checkout system, wherein the self checkout system comprises at least one self checkout station coupled to a server, the method comprising:

receiving a coupon from a customer, wherein the coupon is a paper coupon that is fed into a coupon reader of the at least one self checkout stations (Fig. 7; column 12-61);

attempting to validate the coupon against at least one item scanned by the customer after the couple reader receives the coupon from the customer (Fig. 11; column 7, line 52 – column 8, line 11);

collecting tracking information related to the coupon and storing the tracking information in a file at the server Column 7, lines 12 – 44);

transmitting the electronic coupon from the one self checkout station to the server (column 6, line 63 – column 7, line 44);

Lee further discloses scanning coupons using a UPC scanner (Fig. 7, column 7, lines 12- 61);converting the paper coupon into an electronic coupon.

Lee does not explicitly disclose converting a paper coupon into an electronic coupon;

storing the electronic coupon into one of two coupon pools at the server if the coupon fails to validate against the at least one item, wherein one coupon pool is a

global pool having coupons stored in the global pool which are accessible by all customers, wherein the other coupon pool is a personal pool that is associated with the customer such that coupons stored in the personal pool are accessible only by the customer, wherein the tracking information comprises the coupon pool in which the coupon is stored, wherein the stored electronic coupon can be utilized at a subsequent sales transaction, wherein the global pool allows the second customer to search the global pool for a coupon that validates against an item scanned by the second customer during the subsequent sales transaction, wherein the global pool allows a second customer in the subsequent sales transaction to utilize the coupon, wherein a value of the coupon is deducted from a price of the item if the coupon and the item are validated, and wherein the personal pool allows the customer to access the global pool, select at least one coupon in the global pool, and transfer the selected coupon to a personal account at the server; allowing the customer to search one or more of the global pool and the personal pool for coupons that can be applied to any scanned items by the customer.

However, Trika teaches scanning a printed coupon in order to convert it to an electronic coupon (paragraph [0020]);

storing the electronic coupon into one of two coupon pools at the server if the coupon fails to validate against the at least one item, wherein one coupon pool is a global pool having coupons stored in the global pool which are accessible by all customers, wherein the other coupon pool is a personal pool that is associated with the customer such that coupons stored in the personal pool are accessible only by the

customer, wherein the tracking information comprises the coupon pool in which the coupon is stored, wherein the stored electronic coupon can be utilized at a subsequent sales transaction, wherein the global pool allows the second customer to search the global pool for a coupon that validates against an item scanned by the second customer during the subsequent sales transaction, wherein the global pool allows a second customer in the subsequent sales transaction to utilize the coupon, wherein a value of the coupon is deducted from a price of the item if the coupon and the item are validated, and wherein the personal pool allows the customer to access the global pool, select at least one coupon in the global pool, and transfer the selected coupon to a personal account at the server; allowing the customer to search one or more of the global pool and the personal pool for coupons that can be applied to any scanned items by the customer (Figure 2, paragraphs [0017, 0022-0025, 0029-0032, 0035-0036]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Trika's converting paper coupon to an electronic coupon and storing a coupon in global and personal account to Lee's coupon processing. One would be motivated to do this in order to increase the usage of coupon among consumers.

Lee does not explicitly disclose allowing the customer to choose whether to store the unvalidated coupon, if the customer chooses to store the unvalidated coupon;

destroying the paper coupon after the paper coupon has been converted into an electronic coupon.

However, Rando teaches returning an invalid coupon to the customer (Figure 1); and

destroying the paper coupon after the paper coupon has been converted into an electronic coupon (column 3, lines 49 – 57; column 9, lines 54- 58).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Rando's allowing a customer to choose to store an invalid coupon and destroying a paper coupon to Lee's coupon processing. One would be motivated to do this in order to increase the usage of coupon among consumers and reduce the chance of fraud in the system.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al (6,837,428) in view of Trika et al. (2005/0131761) further in view of Rando et al., (5,128,520) further in view of Mastrianni et al., (2007/0156513) in further view of Goodwin, III et al., (6,696,920).

As per claim 8, Lee does not explicitly disclose receiving the tracking information in the file by an item manufacturer, accessing the global pool at the server by the item manufacturer, selecting at least one coupon in the global pool

However, Trika discloses receiving the tracking information in the file by an item manufacturer, accessing the global pool at the server by the item manufacturer, selecting at least one coupon in the global pool (paragraphs [0030]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Trika's accessing the manufacturer server to Lee's

coupon processing. One would be motivated to do this in order to increase the usage of coupon among consumers and reduce the chance of fraud in the system.

The Lee, Trika and Rando combination does not explicitly disclose analyzing the tracking information for the selected coupon;

modifying the selected coupon by modifying a price of the item based on the analysis and by modifying an expiration date of the selected coupon; and

implementing the modified price immediately via an electronic shelf label associated with the item

However, Mastrianni teaches a manufacturer modifying a coupon's price and expiration date based on analysis (paragraphs [0013, 0037, 0045]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Mastrianni's to manufacturer modification of price and expiration date to Lee's coupon processing. One would be motivated to do this in order to provide a manufacturer with flexibility and the ability to react quickly to market analysis in their coupon programs.

The Lee, Trika and Rando combination does not explicitly disclose implementing the modified price immediately via an electronic shelf label associated with the item.

Goodwin, teaches a method of changing an electronic price label display sequence with the step for implementing the modified price immediately via an electronic shelf label associated with the item (column 2, lines 63 through column 3, lines 1 – 6)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Goodwin's implementation of changes in price and expiration date to Lee's coupon processing. One would be motivated to do this in order to provide a manufacturer with flexibility and the ability to react quickly to market analysis in their coupon programs.

Response to Arguments

7. Applicant's arguments filed July 22, 2008 have been fully considered but are moot in view of the new ground(s) of rejection. Please see the addition of Trika and Rando to the rejection of the independent and dependent claims above. Examiners also notes the following:

on page 10 of the Applicant's remarks, Applicant states that " Lee fails to teach or suggest attempting to validate the coupon against at least one item scanned by the customer after the couple reader receives the coupon from the customer." Examiner respectfully disagrees since Lee discloses the shopper may scan coupons related to the items previously scanned. Additionally, the system may receive a coupon from a customer, wherein the coupon is a paper coupon that is fed into a coupon reader of the at least one self checkout stations (Fig. 7; column 12-61).

Applicant further argues "nowhere does Lee teach that the coupon collection box performs any validation function." Examiner respectfully disagrees, Lee discloses a validation process where a scanned coupon is matched using the vendor code from the coupon against the vendor code of the scanned item in the order (column 7, lines 51-61). Lee also discloses attempting to validate the coupon against at least one item

scanned by the customer after the couple reader receives the coupon from the customer (Fig. 11; column 7, line 52 – column 8, line 11).

Applicant further argues that "Lee fails to teach or suggest a choice that a customer makes with an unvalidated coupon." Arguing further that "this clearly teaches away from allowing the customer to choose whether to store the unvalidated coupon, as in the present invention." Examiner agrees that Lee does not explicitly disclose allowing the customer to choose whether to store the unvalidated coupon, if the customer chooses to store the unvalidated coupon;

destroying the paper coupon after the paper coupon has been converted into an electronic coupon.

However, Rando teaches returning an invalid coupon to the customer (Figure 1); and

destroying the paper coupon after the paper coupon has been converted into an electronic coupon (column 3, lines 49 – 57; column 9, lines 54- 58).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Rando's allowing a customer to choose to store an invalid coupon and destroying a paper coupon to Lee's coupon processing. One would be motivated to do this in order to increase the usage of coupon among consumers and reduce the chance of fraud in the system.

Examiner agrees with Applicant that Lee does not explicitly disclose "the coupon pools, wherein one coupon pool is a global pool having coupons stored in the global pool which are accessible by all customers, wherein the other coupon pool is a personal

pool that is associated with the customer such that coupons stored in the personal pool are accessible only by the customer." However, Trika teaches storing the electronic coupon into one of two coupon pools at the server if the coupon fails to validate against the at least one item, wherein one coupon pool is a global pool having coupons stored in the global pool which are accessible by all customers, wherein the other coupon pool is a personal pool that is associated with the customer such that coupons stored in the personal pool are accessible only by the customer, wherein the tracking information comprises the coupon pool in which the coupon is stored, wherein the stored electronic coupon can be utilized at a subsequent sales transaction, wherein the global pool allows the second customer to search the global pool for a coupon that validates against an item scanned by the second customer during the subsequent sales transaction, wherein the global pool allows a second customer in the subsequent sales transaction to utilize the coupon, wherein a value of the coupon is deducted from a price of the item if the coupon and the item are validated, and wherein the personal pool allows the customer to access the global pool, select at least one coupon in the global pool, and transfer the selected coupon to a personal account at the server; allowing the customer to search one or more of the global pool and the personal pool for coupons that can be applied to any scanned items by the customer (Figure 2, paragraphs [0017, 0022-0025, 0029-0032, 0035-0036]).

Applicant further argues that Lee does not disclose a manufacturer modifying a coupon's price and expiration date based on analysis. Applicant further argues that Mastrianni also fails to teach or suggest "modifying the selected coupon by modifying a

price of the item based on the analysis and by modifying an expiration date of the selected coupon," also argues that "nowhere does Mastrianni teach or suggest modifying a coupon's expiration date." Examiner respectfully disagrees since Mastrianni teaches a manufacturer modifying a coupon's price and expiration date based on analysis (paragraphs [0013, 0037, 0045]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Mastrianni's to manufacturer modification of price and expiration date to Lee's coupon processing. One would be motivated to do this in order to provide a manufacturer with flexibility and the ability to react quickly to market analysis in their coupon programs.

Examiner respectfully notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Note, as stated above, that the claims can be interpreted in different ways because of the broad disclosure of the claims.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALVIN L. BROWN whose telephone number is (571)270-5109. The examiner can normally be reached on Monday - Thursday 7:30 AM to 5:00 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571 272 6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ALB

/Arthur Duran/
Primary Examiner, Art Unit 3622
9/22/2008